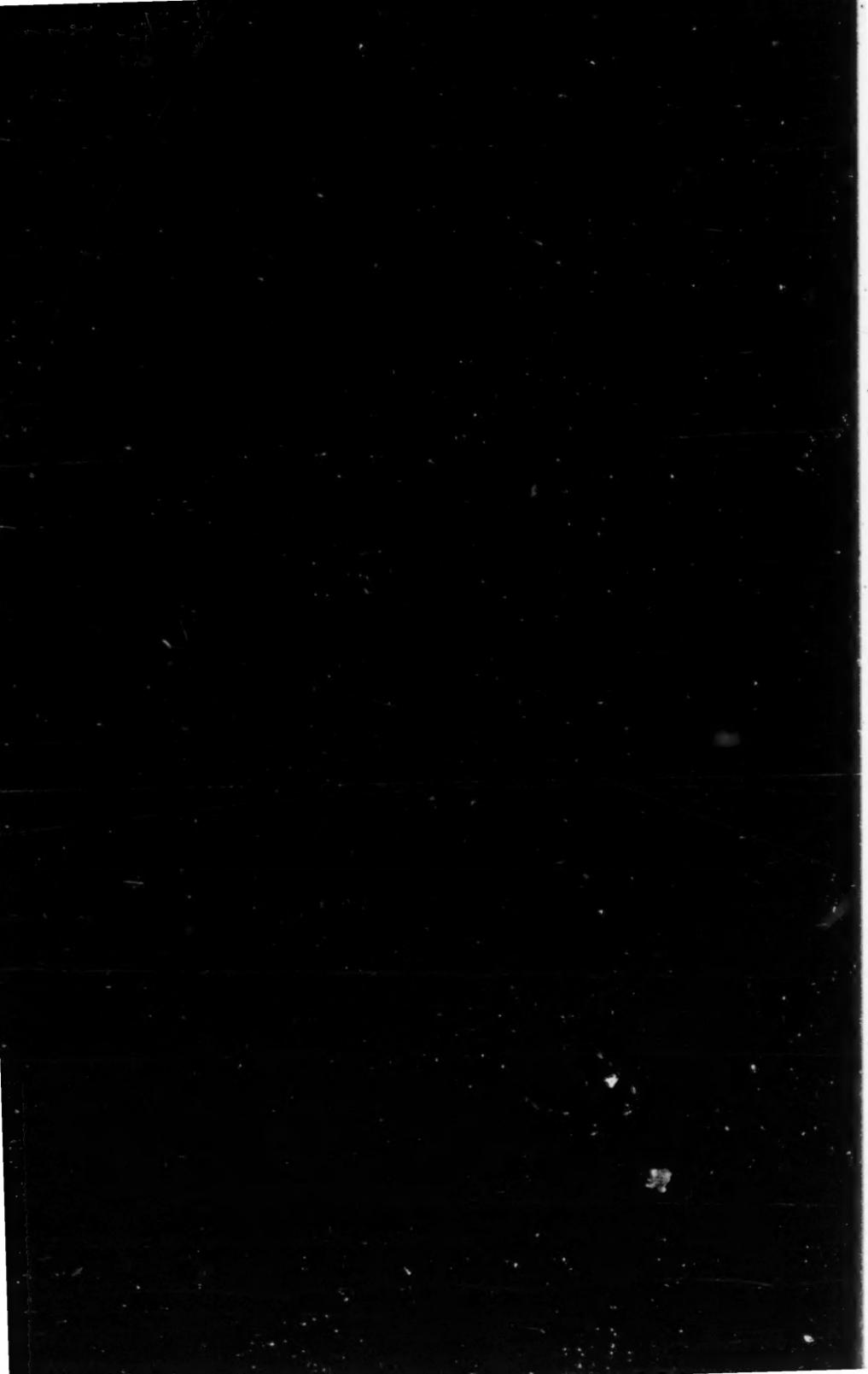
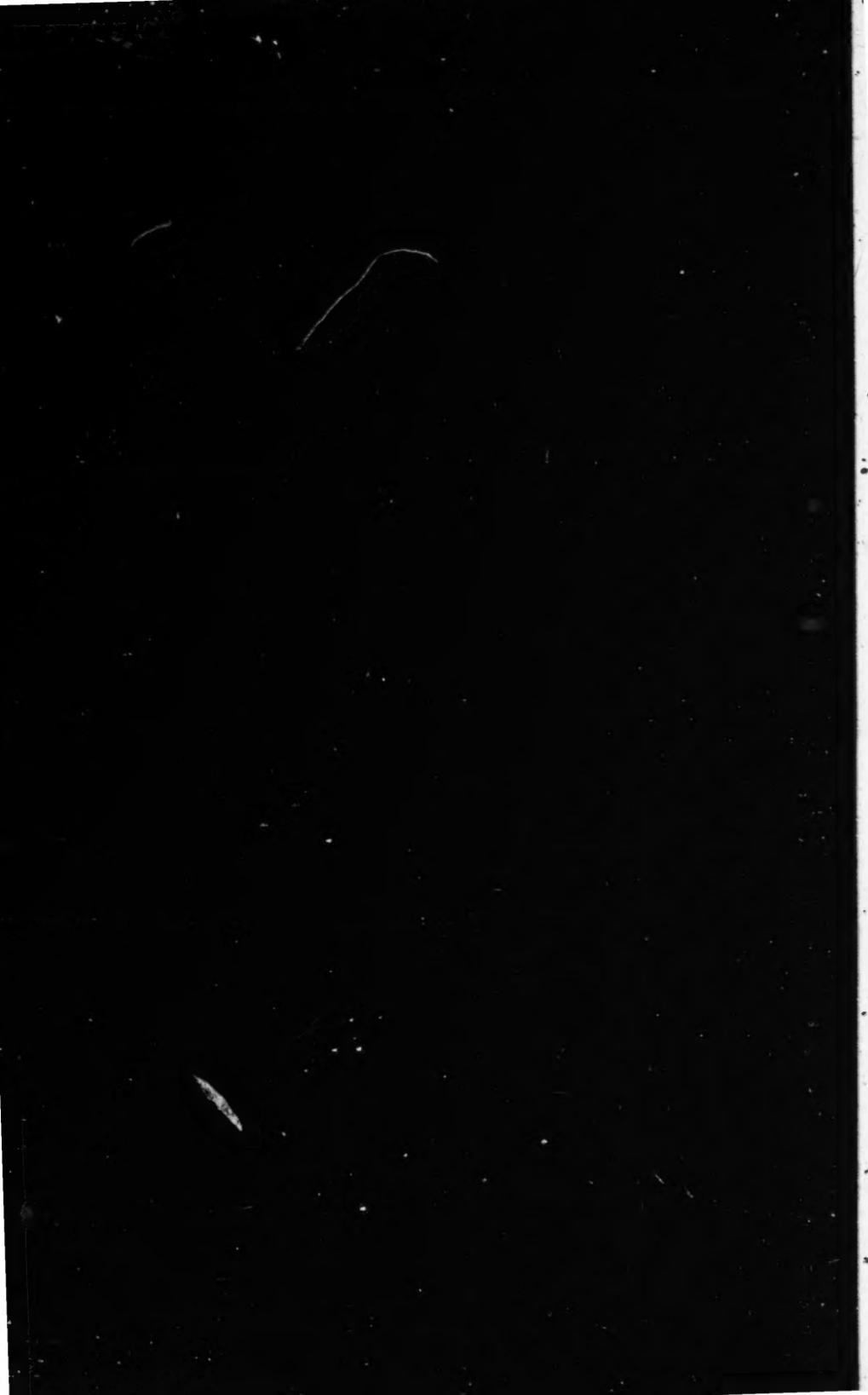




The Wilkinson-Sloat Printing Co.,
1217 Jackson St., Toledo, O.





IN THE
Supreme Court of the United States

No. 441, October Term, 1938.

THE ELECTRIC STORAGE BATTERY CO.,
Petitioner.

vs.

GENZO SHIMADZU and NORTHEASTERN ENGINEERING
CORPORATION,

Respondents.

BRIEF FOR RESPONDENTS

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INDEX

	Page
Opinions Below	1
JURISDICTION	2
STATEMENT OF THE CASE	3
SUMMARY OF ARGUMENT	6
ARGUMENT	8
POINT I	8
Under All the Pertinent Patent Statutes, it is Clear that a Patentee as Against an Infringer May Prove Acts Done in a Foreign Country to Antedate an Alleged Prior Use in This Country Where There Is No Contest as to Priority for the Patent Rights to the Same Invention	8
History of Changes in Pertinent Sections of Patent Statutes Clearly Supports Concurrent Conclusions of the Courts Below that Re- spondents had the Right to Introduce the Ante- dating Testimony of Acts Done in a Foreign Country	11
History and Effect of R. S. 4886	11
History and Effect of R. S. 4887	18
Effect of R. S. 4892	22
Effect of R. S. 4920	23
Respecting Certain of Petitioner's Conten- tions, Respondents Submit	24

	Page
Respondents' Position Is Not Based on a Mere Altruistic Theory that the United States Should Allow Persons All Over the World to Obtain Patents Here But, on the Contrary, by so Doing the American Public and Industry Has and Will Continue to Profit Thereby	29
It is Well Settled that a Domestic Inventor May Introduce Fact Testimony to Establish His Dates of Invention	32
Conclusion Point 1	33
 POINT II	 38
(1) Suppression and Concealment of Invention Were Neither Pleaded by the Petitioner in the Answer nor Urged Before Either the District Court or the Circuit Court of Appeals; Therefore Such Alleged Defenses Not Properly Before This Court	38
(2) In any Event the Record Fails to Show any Suppression or Concealment by Shimadzu of His Inventions During Which any Intervening Rights Accrued So as to Warrant Invalidating His Patents	39
 POINT III	 46
The Concurrent Holdings by the Courts Below of Validity of the Patents in Suit Should Not be Disturbed Irrespective of Petitioner's Alleged "Public Use"	46
(1) Admittedly There Can be no Such Defense Against Patent No. 1,584,149	46
(2) The Defense of Alleged Public Use Was Not Properly Pleaded and Therefore that Question is Not Open to This Court	46

Page

(3) Both Lower Courts Having in Effect Found That the Inventions of the '150 and '020 Patents Were Not in Public Use Within the Meaning of R. S. 4886 by Holding Said Patents Valid Have Resolved a Question of Fact in Respondents' Favor Which has Unquestionable Support by the Record and Should Not be Disturbed Here	49
(4) There is Ample Evidence to Support the Concurrent Findings Below, in Fact the Record Clearly Establishes that the Inventions in Suit Were Not in Public Use for More than Two Years Prior to the Actual Filing of the Application for the '150 Patent nor for the '020 Patent Which is Entitled to the Same Filing Date	50
(5) There is No Proof of Public Use of the Process as Distinguished from the Product	53
(6) Hall's Oaths in His Patent Applications and Preliminary Statements Executed Prior to this Litigation Estop Defendant From Claiming "Public Use" Based on Identical Activities Referred to in Said Oaths	58
CONCLUSION	61
APPENDIX	ii

AUTHORITIES CITED

	Page
Abrahams v. Universal Wire Co., Inc., 10 Fed. (2d) 638, 842	47
Angle v. Richardson, 19 Fed. Supp. 1002, 1004	47
Badische Anilin & Soda Fabrik v. A. Klipstein & Co., 125 F. 543	37
Barber v. Otis Motor Sales Co., 265 Fed. 675, 679	33
Bates v. Coe, 98 U. S. 31, 34	32
Blair v. Oesterlein Co., 275 U. S. 220, 225	7
Brown v. Duchesne, 19 How. 183	29
The Byrne Manufacturing Company v. American Flange & Manufacturing Co., Inc., 58 Sup. Ct. 18	47
Claude Neon Lights, Inc., et al., v. Rainbow Light, Inc., 47 F. (2d) 545, 346	17, 37
Cline Electric Mfg. Co., et al., v. Kohler, 27 Fed. (2d) 638, Certiorari denied, 49 S. Ct. 82	55
DeKando v. Armstrong, 37 App. D. C. 314, 319	17
Dewey v. United States, 178 U. S. 510, 521	14
Downton v. Yeager Milling Company, 108 U. S. 466, 471, 477	29
Duignan v. United States, 274 U. S. 195, 200	7
Eibel Process Co. v. Minneapolis & Ontario Paper Co., 261 U. S. 45	50
Electric Storage Battery Co. v. Shimadzu, et al., 98 F. (2d) 831	36

	Page
Elizabeth v. Pavement Co., 97 U. S. 126	7, 33, 54, 55
Ex Parte Grosselin, 97 O. G. 2977, C. D. (1901) 248, 256	27, 28
Gayler v. Wilder, 10 How. 477, 497	15, 16
General Talking Pictures Corp. v. Western Electric Co., et al., 304 U. S. 175, 178, 179, 183	2, 7, 27, 40, 42, 49
Hall v. Shimadzu, 59 F. (2d) 225	6
Hanifen v. E. H. Godshalk Co., 78 F. 811	27, 33, 37
Hanifen v. Price, 96 F. 435	27
Ireson v. Pierce, 39 Fed. 795	25
Keller v. Adams-Campbell Co., 264 U. S. 314, 319	3
Kendall v. Winsor, 21 How. 322, 328	42
Lake County v. Rollins, 130 U. S. 662, 670	14
Loom Company v. Higgins, 105 U. S. 580, 592	33
Milburn Co. v. Davis, et al., Co., 270 U. S. 390, 402	9
Patents Selling & Exporting Co. v. Dunn, 213 F. 40	28
Rebuffat v. Crawford, 68 F. (2d) 980, 982	16
Rosenwasser v. Spieth, 129 U. S. 47, 50, 52	29
Rubber Co. v. Goodyear, 76 U. S. 788, 801	7, 39, 48

	Page
St. Paul Plow Works v. Starling, 140 U. S. 184, 198	33
Shimadzu, et. al., v. Electric Storage Battery Co., 17 F. Supp. 42	1
Shimadzu, et. al., v. Electric Storage Battery Co., 36 U. S. P. Q. 25	1
Smith v. Barter, 7 O. G. 1, 1875, C. D. 8	16
Spaulding v. Wanamaker, 256 Fed. 530	22
Treat v. White, 181 U. S. 264, 267	14
U. S. v. Dubilier Condenser Corp., 289 U. S. 178, 186	31
U. S. Rifle and Cartridge Co. v. Whitney Arms Co., 118 U. S. 22	45
Vacuum Engineering Co. v. Dunn, 209 F. 219	28
Victor Talking Machine Co. v. Starr Piano Company, 281 Fed. 60	44
Walker on Patents, Sixth Edition, pgs. 115, 116	23
Webster Co. v. Splitdorf Co., 264 U. S. 463	45
Webster's New International Dictionary, Second Edition, Unabridged, 1936	51
Welsbach Light Co. v. American Incandescent Lamp Co., 98 F. 613	27, 37
Wilson, et. al., v. Sherts, et. al., 81 F. (2d) 755	16
Wirebounds Patents Co. v. Saranac Automatic Mach. Corp., 65 Fed. (2d) 904	44
Woodbridge v. U. S., 263 U. S. 50	45

STATUTES AND MISCELLANEOUS CITATIONS

	Page
Congressional Record, February 16, 1903, p. 2275	30
Judicial Code, §240 (a)	2
Nolan Act	24
Patent Act of 1790 (1 Stat. 109, §1)	11, 12
Patent Act of 1793 (1 Stat. 318, §1)	11, 12, 6-a
Patent Act of 1800, §1	11, 12, 6-a
Patent Act of 1836 (5 Stat. 117) §6, §15	11, 12, 13, 7-a, 9-a
Patent Act of 1870 (16 Stat. 198) §24, §25	13, 8-a, 10-a
Patent Act of 1897 (29 Stat. 692)	13, 8-a, 11-a
Patent Act of 1903	11-a
R. S. 4886	10, 11, 12, 17, 18, 26, 37, 38, 55, 1-a, 6-a
R. S. 4887	18, 19, 29, 1-a, 2-a, 9-a, 10-a, 11-a
R. S. 4892	17, 22, 2-a, 3-a
R. S. 4915	24
R. S. 4918	24
R. S. 4920	17, 23, 46, 47, 3-a
R. S. 4923	8, 9, 17, 26, 35, 37, 4-a, 12-a
Rule 126 of the Rules of the United States Patent Office (Appendix)	5-a

IN THE

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No. 441, October Term, 1938.

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Petitioner.

vs.

GENZO SHIMADZU and NORTHEASTERN ENGINEERING
CORPORATION,

Respondents.

On Writ of Certiorari to the United States Circuit Court
of Appeals for the Third Circuit.

BRIEF FOR RESPONDENTS

Opinions Below

The opinion of the District Court for the Eastern District of Pennsylvania (R. II, 1162-1189) is reported in 17 F. Supp. 42. A supplemental opinion of the District Court, not included in the record filed by petitioner, is reported in 36 U. S. P. Q. 25. The opinion of the Court of Appeals for the Third Circuit is reported in 98 F. (2d) 831.

JURISDICTION

While jurisdiction in this Court is invoked under the Judicial Code, §240 (a), as amended, respondents respectfully submit that there was no real ground for the application for certiorari in this case for the following reasons:

(1) As to petitioner's point I, there is no conflict in the ruling of Federal Courts permitting a foreign inventor to take antedating testimony of acts abroad in a suit for infringement not involving a contest of priority for the same invention¹. Hence there is no unsettled point of law requiring determination by this Court.

(2) As to petitioner's Points II and III, both are mere questions of fact resolved in favor of respondents by concurrent decisions of the Courts below, which were supported by the proofs and hence should not be disturbed. This Court in **General Talking Pictures Corp. v. Western Electric Co., et al.**, 304 U. S. 175, 178, stated:

"Moreover, the decision on that point rests on concurrent findings. They are not to be disturbed unless plainly without support. **United States v. Chemical Foundation**, 272 U. S. 1, 14. **United States v. McGowan**, 290 U. S. 592. **Alabama Power Co. v. Ickes**, 302 U. S. 464."

Furthermore, as to Points II and III, there is no conflict on the same patent between different Circuit Courts of Appeals.

¹This suit is against petitioner as an infringer. After the Hall-Shimadzu interference decided adversely to Hall (petitioner's engineer) 59 Fed. (2d) 225, Hall accepted limited claims distinguished from this invention.

Under the decisions of this Court, respondents submit the result should be an order in accordance with the following ruling of this Court in **Keller v. Adams-Campbell Co.**, 264 U. S. 314, 320:

"Dismissing the writ of certiorari as improvidently granted at the costs of the petitioner. **Layne & Bowler Corporation v. Western Well Works, Inc.**, 261 U. S. 387; **Furness, Withy & Co. v. Yang-Tsze Insurance Association**, 242 U. S. 430; **United States v. Rinier**, 220 U. S. 547."

STATEMENT OF THE CASE

Respondents make the following corrections, exceptions and additions to petitioner's statement of the case. A reading of the claims of the patents in suit will show that they are not all limited to the process being conducted in a dry state, nor did the Courts below make the distinction between the patent No. 1,584,149 and the patent No. 1,584,150 as indicated in petitioner's Footnote 4. The Court stated (R. II, 1167) that patent No. 1,584,149 does not specify the temperature "control" (regardless of temperature at which the mill is operated).

Petitioner's statement on Page 4 of its brief, question (1), that respondents rely on oral evidence is incorrect. They rely as well on the many documentary exhibits, particularly including PX-10, a large drawing of Shimadzu's mill which was not only dated but was acknowledged before a Notary Public in Japan in 1919 (PX-10) and Ishimura's notebooks (PX-7, 7-A, 8, 8-A).

Page 6 of petitioner's brief (7), respondents desire to correct the impression made by petitioner that the

only purpose in introducing the early testimony by Shimadzu was to carry the dates of invention back of June, 1921. The object was to show in particular the difficulties encountered by respondent in making the important inventions of the patents in suit, and the history thereof, and to establish Shimadzu's real date of invention for all purposes. At that time respondents knew nothing of any alleged importance of the date of June, 1921.

Respondents also desire to point out that petitioner's statement with respect to witnesses Cooper and Nagle, Page 8 of its brief (11), is not accurate, as Cooper entered and left petitioner's employ after the critical period (1921), and Nagle was employed while Cooper was there. There is no evidence as to when he entered or left petitioner's employ.

The petitioner pleaded several defenses under R. S. 4886, including prior knowledge and use by others in this country before Shimadzu's inventions and that Shimadzu was not the first inventor of the subject matter of the patents in suit. Notwithstanding statements to the contrary, petitioner did not plead a prior "**public use**" based on its operation of its Hardinge Mill for more than two years prior to the filing of the applications of the patents in suit (R. I. 28-44).

Likewise, the record in this case does not disclose that petitioner pleaded suppression and concealment of these inventions, much less suppression and concealment vis-a-vis persons in the United States, nor do the opinions of the Courts below reveal any definite finding on this alleged issue.

Respondents introduced evidence at the trial to show that Shimadzu conceived and reduced the inventions to practice in Japan earlier, and the Courts below found this to be not later than August, 1919 (R. II, 1166). While the petitioner objected to such evidence, the Courts below held that the respondents were "undoubtedly entitled to rely for priority upon the date of invention and reduction to practice as found, regardless of the fact that the invention was made in a foreign country." (R. II, 1178.)

While the petitioner quotes the statement by the Courts below with respect to the commercial production by the Hardinge Mill in 1921, attention is also called to the fact that both lower Courts were careful not to find such use to be a "public use".

The Hall process, employing the Hardinge Mill, which petitioner contends it has been using since 1921, and thus that it constitutes prior knowledge and use, as well as an alleged prior "public use" of the respondents' inventions was the subject matter of bitterly contested interference proceedings in the Patent Office for several years prior to the commencement of the present suit. Hall, petitioner's engineer, who under its direction conducted the various experiments with this process since 1921 in petitioner's plant, did not file an application for a United States patent until March 29, 1924. In this patent application (PX-17, 18) and in two preliminary statements in the interferences (PX-41, pgs. 29, 32, 259), Hall swore that these identical actions were not a "public use" more than two years prior to his application.

The Patent Office tribunals and the Court of Customs and Patent Appeals uniformly held that Hall had failed to establish conception or reduction to practice of the counts of the interference prior to the filing date of Shimadzu's patent No. 1,584,150, which was July 14, 1923, and awarded priority to respondent Shimadzu. (Hall v. Shimadzu, 59 Fed. (2d) 225.)

SUMMARY OF ARGUMENT

As to Point I, respondents respectfully submit that under all the pertinent patent statutes and the authorities, a patentee as against an infringer is clearly entitled to prove acts done in a foreign country to antedate an alleged prior use in this country where there is no contest as to priority for the patent rights to the same invention.

- (1) A contest of priority of invention between rival claimants for the same patent rights has a different status in the law and is governed by different rules and principles than those governing the rights of a patentee to establish that he is in fact the first inventor to overcome the defense of prior knowledge and use in this country as against an infringer urging the same.
- (2) The history and construction of the pertinent sections of the patent statutes and the authorities support the concurrent conclusions of the Courts below that respondents had the right to introduce proofs of inventive acts in a foreign country.

In connection with Point II, respondents submit--

- (1) That the alleged issues of suppression and concealment were presented neither by the pleadings nor the proofs at the trial, nor were they mentioned on the argu-

ment nor in petitioner's briefs before the District Court nor in the Circuit Court of Appeals, and cannot therefore be properly raised here for the first time. **Rubber Co. v. Goodyear**, 76 U. S. 788, 801; **Duignan v. United States**, 274 U.S. 195, 200; **Blair v. Oesterlein Co.**, 275 U. S. 220, 225.

(2) That from the proofs submitted on other points, however, the record shows that there was no concealment, suppression or abandonment of the inventions by Shimadzu.

In connection with Point III, respondents submit:

(1) That the alleged public use, based on petitioner's 1921 Hall activities, was not only not pleaded but particularly avoided in the pleadings by petitioner;

(2) That the proofs in this case show:

(a) The alleged use was not "public" within the meaning of the statute, R. S. 4886;

(b) Petitioner's alleged use was certainly experimental even though on a commercial scale under the doctrine of this Court in the case of **Elizabeth v. Pavement Co.**, 97 U. S. 126, until so long subsequent to the critical date as to render this belated defense of no avail;

(c) Petitioner is estopped by the three oaths made in Hall's application and in the interferences from now claiming that the identical activities affirmed at that time under oath not to have been in public use, constitute such a use;

(3) A question of "public use" being one of fact, and both lower Courts herein having found the patents in suit valid, these concurrent holdings should not be disturbed here as there is ample proof for the support of the same. **General Talking Pictures Corp. v. Western Electric Co., et al.**, 304 U. S. 175, 178, 179.

ARGUMENT.

POINT I

Under All the Pertinent Patent Statutes, it is Clear that a Patentee as Against an Infringer May Prove Acts Done in a Foreign Country to Antedate an Alleged Prior Use in This Country Where There is no Contest as to Priority for the Patent Rights to the Same Invention.

A consideration of the brief presented by the petitioner indicates that petitioner has failed to distinguish between true contests of priority in which rival claimants are attempting to secure patent rights covering the same invention, and the issue which arises when, in an infringement suit, the defendant alleges that the patentee of the patent in suit was not the first inventor. These two situations are entirely different and are properly governed by different rules of law. In the first situation, the interests of the public are served equally well irrespective of to whom the patent is ultimately awarded. The struggle is merely between two or more aspirants for the rights to a monopoly. The Courts, in construing R. S. 4923, have held in effect that in this situation, a domestic inventor should be given a preference to the extent that knowledge and use of his invention in a foreign country prior to the date of his invention should not operate to prejudice his rights.² The purpose of

² All the cases referred to by petitioner and all others known to respondents base the fundamental reason for this policy of law upon the wording of R. S. 4923, which is limited to cases where it is necessary to protect "the thing patented" (or about to be patented) as clearly specified in that section. It has no application whatever to the facts of the instant case, especially where the activities constituting the alleged prior use now relied upon by petitioner were first sought to be patented, but by amendment in the Patent Office, Hall (and hence petitioner) accepted limitations, thereby becoming forever estopped to claim patent rights to the inventions patented to respondent.

R. S. 4886 and R. S. 4923 in excluding from the statutory bars knowledge and use in a foreign country is to bestow such preference upon domestic inventors. The reason for this rule is obvious. It would be unjust to penalize an inventor in this country who in good faith devoted his time and energy to the making and perfecting of an invention and then by denying him the right to a patent by reason of the existence of an unpublished, unavailable knowledge or use of his invention in some foreign country.

Manifestly, this situation is entirely different from that of a patentee against whose patent an infringer has alleged as a defense that the patentee is not the first inventor of the subject matter of the patent, and that the invention was known or used in this country prior to the date upon which it was made by the patentee. In this latter situation, there is no rival claimant for the right to the patent. Therefore there is no one to receive the preference which is given to domestic inventors under R. S. 4923. Public interest is not here involved as the patentee has already made a full disclosure of his invention in the application and patent to the public under a contract whereby it will become public property at the expiration of seventeen years from the date of the patent. To be eligible to obtain a patent, a person must be a first inventor. **Milburn Co. v. Davis etc. Co.**, 270 U. S. 390. If the validity of his patent is attacked on the ground that he was not in fact the first inventor, he should be entitled to overcome allegations to that effect by establishing the date of his invention. It would be absurd indeed to say that, in order to obtain a patent, a person must

comply with certain definite requirements and, after he has obtained his patent, to deny to him the right to establish that he had complied with the required conditions, if at any time his compliance were challenged. The explicit wording of R. S. 4886, as well as sound logic, gives to the patentee the right to meet all such challenges by establishing and relying upon his actual date of invention irrespective of where made.

If this distinction is borne in mind the issue intended to be raised by petitioner under its caption, Point I, becomes clear and simplified. It becomes apparent at once that the sole question presented is covered by R. S. 4886.

Petitioner's Point I is stated much more broadly than is warranted by any issue presented in this case. The precise question for the determination of this Court is whether the phrase "in this country" should be read into R. S. 4886 immediately following the words "before his invention or discovery thereof" (both occurrences) to limit the time and place of invention or discovery. Stated differently, the question is whether R. S. 4886 should be construed as though it read as follows:

"Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof (in this country),³ and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof (in this country),³ or more

³ Insert in Parentheses ours.

than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

A brief consideration of the history of the United States Patent Statutes reveals that the inclusion of such words was not intended nor can it be justified.

History of Changes in Pertinent Sections of Patent Statutes Clearly Supports Concurrent Conclusions of the Courts Below that Respondents had the Right to Introduce the Antedating Testimony of Acts Done in a Foreign Country.

History and Effect of R. S. 4886

The Patent Act of 1790 (1 Stat. 109, §1) * authorized the grant of Letters Patent to "any person or persons" who made an invention "not before known or used". However, the Act of 1793 (1 Stat. 318 §1) limited patentees to "a citizen or citizens of the United States". By the Act of 1800, §1, the right to obtain a patent was extended and given to all aliens who at the time of petitioning in the manner prescribed by said Act, shall have resided for two years within the United States". The Act of 1836 (5 Stat. §6) restored the right to obtain a patent to "any person or persons" without limitation, but specified much higher application fees for citizens of foreign countries than for citizens of the United States. This difference has long since been eliminated

* All pertinent sections of the Patent Statutes are printed in the Appendix.

from the statutes. R. S. 4886 as now in effect still provides that "any person" (without limitation as to citizenship or place of invention) may obtain a patent.

R. S. 4886 further provides, as one condition for obtaining a patent, that the invention shall not have been "known or used by others in this country, before his invention or discovery thereof". The predecessor of this statutory bar originally appeared in the Act of 1790 (1 Stat. 109) and read "not before known or used". §1 of the Act of 1793 (1 Stat. 318) amended this clause to read not "known or used **before the application.**"⁵ It is important to note that the Act of 1800, §1, required an applicant to swear that his invention had not "been known or used in this or any foreign country". The Act of 1836, §6, (5 Stat. 117) amended the prior knowledge and use clause to read "**not known or used by others before his invention or discovery thereof**". Thus, the knowledge or use, to constitute a bar to the grant of a patent under the latter act, must have been prior to the date of invention instead of simply the application date. It is important to note that none of the statutes so far referred to imposed any limitation as to the place of invention or discovery. Thus we find this major difference between the Act of 1836 and those that preceded it. By establishing the actual date of invention as the date before which the invention must have been known or used in order to bar the grant of a patent, and by failing to impose limitations as to the place of invention or discovery, Congress extended to inventors

⁵Unless otherwise indicated, emphasis throughout the brief is ours.

the right to rely upon their actual date of invention whether made in the United States or a foreign country to defeat prior knowledge or prior use. Prior to the Act of 1836, neither an inventor in the United States nor an inventor in a foreign country could rely upon his actual date of invention to overcome prior knowledge or prior use because of the statutory provision that such knowledge or use would defeat the patent if it antedated the application date thereof.

However, §24 of the Act of 1870 (16 Stat. 198) expressly limited the prior knowledge or use which would constitute a bar to that occurring "in this country", but significantly failed to impose a similar limitation on the place of "invention or discovery".

The Act of 1897 (29 Stat. 692) effected no change in the substance of this clause. It employed identical, although rearranged, wording, to wit, that other conditions having been met, a patent may be obtained if the invention was "not known or used by others in this country before his invention or discovery thereof". This is the way the clause reads today.

Prior to the Act of 1870 no limitation was placed upon the place where the prior knowledge or use occurred, except that provided for in §15 of the Act of 1836 which required that prior knowledge or use in a foreign country, to constitute a bar to the grant of a United States patent, must be evidenced by a printed publication or a patent. The failure of Congress to amend the statute to limit the place of "invention or discovery" to this country must be accepted as conclusive of the fact that no such limitation was intended or should

be now applied, particularly when it is considered that by the Act of 1870 the place of "knowledge or use" was expressly so limited.

From this history the intent of Congress is clear. The statute is unambiguous and should be given the natural and ordinary meaning. See **Lake County v. Rollins**, 130 U. S. 662, 670; **Treat v. White**, 181 U. S. 264, 267; **Dewey v. United States**, 178 U. S. 510, 521, where this Court stated:

"Our province is to declare what the law is, and not, under the guise of interpretation or under the influence of what may be surmised to be the policy of the Government, so to depart from sound rules of construction as in effect to adjudge that to be law which Congress has not enacted as such. Here, the language used by Congress is unambiguous. It is so clear that the mind at once recognizes the intent of Congress. Interpreted according to the natural import of the words used, the statute involves no absurdity or contradiction, and there is consequently no room for construction. Our duty is to give effect to the will of Congress, as thus plainly expressed."

What justification can there be, therefore, for construing the present R. S. 4886 as though the time and place of "invention or discovery" were expressly limited to this country?

We therefore see, retracing the history of the statutes, that whereas the early Act of 1790 provided that the critical date of prior knowledge or prior use be the date of the patent application and that at the same time the knowledge or use might be in a foreign country as well as in the United States, in all subsequent amend-

ments thereto the critical date for this Statutory Bar was the inventor's date of discovery or invention thereof regardless of whether the invention was made in the United States or in a foreign country or made by citizens of the United States or by citizens of foreign countries. The history of the amendments to the statutes in which patents were at one time allowed to citizens of the United States only and then to aliens who resided here for two years (but not other foreign citizens) and then to citizens of any country in the world, as the statute today provides, also clearly shows the intent of Congress to open the doors of our patent system to receive inventions made in foreign countries as well as those made in the United States and to grant patents thereon. The only limitation that has been made with respect to acts in the United States compared with acts in a foreign country is that amendment which limited the invalidation of a patent on prior knowledge or use to knowledge or use "by others in this country" before the invention or discovery. The reason for this is given by this Court in **Gayier v. Wilder**, 10 How. 477, 497, where it was pointed out that where this knowledge or use existed only in remote places even for ages "the people of this country would be unable to profit by it. The means of obtaining knowledge would not be within their reach; and, as far as their interest is concerned, it would be the same as if the improvement had never been discovered." It is true that patenting or printing in a publication in any foreign country as well as the United States constitutes a bar if prior to a patentee's date of invention or discovery, or more than two years prior to his application in the

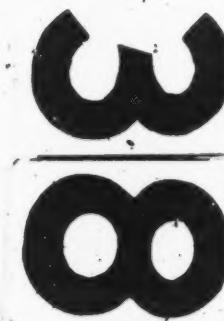
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United States. In other words, patenting or publishing an invention in a foreign country is deemed to make it available to citizens of this country. Likewise, where an inventor makes an invention in a foreign country, whether he be a citizen of the United States or of a foreign country and takes steps by way of filing an application in the United States, he brings it to the United States and this act entitles him to the reward of the patent, all other statutory requirements having been complied with. Hence the principle of law enunciated by this Court in **Gayler v. Wilder**, *supra*, that in contrast to a mere use in a foreign country, where an inventor files an application in this country and thereby benefits the public of the United States "by the effect of his own genius," he is entitled to a patent and the principle that the law "protects his patent" in such cases applies even stronger to the instant case. Under the principle as enunciated in **Gayler v. Wilder**, *supra*, by this Court, it is immaterial whether the inventor bringing the invention to the public of the United States makes the invention in the United States or in a foreign country.

Petitioner relies primarily on the Patent Office Interference Practice and cases in court dealing with contests on priority on the same patent rights. If the line of reasoning in all these cases be traced back, it will be found that R. S. 4923 is the fountain from which it flows. See **Smith v. Barter**, (7 O. G. 1, 1875, C. D. 8). In the opinion in the recent case of **Wilson et al. v. Sherts et al.**, 81 F. (2d) 755, the Court of Customs and Patent Appeals refers to its prior decision of **Rebuffat v. Crawford**,

68 F. (2d) 980, 982, 21 C. C. P. A. Patents 901, which in turns refers to one of the fundamental cases of **De Kando v. Armstrong**, 37 App. D. C. 314, 319, which places practically the entire doctrine of excluding foreign knowledge or use in contests for priority on the same patent rights on RS 4923.

Notwithstanding that the Patent Office and the Courts, in determining priority of rights to a single thing patented or to be patented, may have, under the express provisions of RS 4923, limited the proofs which may be introduced to those acts committed in the United States rather than in any foreign country, respondents submit that under the plain wording of the statutes pertinent to the instant issue, particularly RS 4886, 4892 and 4920—especially in view of the history as herein outlined—all the courts have correctly and consistently held that, in an infringement suit, a patentee may introduce facts showing the early dates of invention, even if made in a foreign country in order to antedate a defense of prior knowledge or prior use. A summary of this rule of law is aptly stated by the Court in **Claude Neon Lights, Inc., et al. v. Rainbow Light, Inc.**, 47 F. (2d) 345, 346, as follows:

"These are two motions for commissions to take testimony abroad.

"The plaintiffs have the right as against an infringer to carry the date of invention of the patent in suit back of its convention date by proof of acts abroad.

Section 4886 of the Revised Statutes of the United States, now title 35, §31, U. S. Code (35 USCA §31), relating to the grant of patents, reads as follows (quoting statute):

"That statute is not limited to inventions made in the United States. See Walker on Patents (6th Edition) §109, p. 136:

"'When a patent is questioned in point of novelty, and when that question depends upon the date of the invention claimed in that patent, it is not material whether the event, which constituted that invention, occurred in the United States or in some other country.' Welsbach Light Co. v. American Incandescent Lamp Co. (C. C. A.) 98 F. 613, at page 615; Hanifen v. E. H. Godshalk Co. (C. C.) 78 F. 811, at page 812; Hanifen v. Price (C. C.) 96 F. 435, at pages 440 and 441; Badische Anilin & Soda Fabrik v. A. Klipstein & Cö. (C. C.) 125 F. 543; Hanifen v. Price (C. C. A.) 102 F. 509."

History and Effect of R. S. 4887

RS 4887 relates to patenting and filing of patent applications for the same invention in foreign countries and in the United States. It says not a word about the question before this Court of whether or not the critical date of the statutory bar of prior knowledge or prior use under RS 4886 is limited to the date of acts done in the United States. On the contrary, as we shall hereinafter point out, there is a clear implication in RS 4887 that the same is not intended to so limit RS 4886. Although there is not a word in RS 4887 as to actual dates or facts relating to the creation of an invention, such as conception and actual reduction to practice—let

alone attempting to contrast such acts made in the United States with those done in a foreign country—petitioner seems to lay great stress on RS 4887 as indicating an intent on the part of Congress to preclude the right of inventors to show the actual date of an invention if made in a foreign country, and to limit the same to some artificial date such as the filing of the application. Such contentions completely ignore the amendments to our patent statutes above referred to changing the critical date of prior knowledge or use, to constitute a statutory bar, from a mere "application date" to the date of the inventor's "invention or discovery thereof"—with no limitation as to whether such invention is made in the United States or in a foreign country.

It is also important to bear in mind that RS 4887 applies to citizens of the United States who may file an application in the foreign country prior to filing the same in the United States as well as to a citizen of a foreign country filing an application first in a foreign country, as this section deals with applications and patents and not with citizenship.

The history of RS 4887 and its predecessor sections requires that only three points be considered: First, the Act of 1870, §25, provided that prior patenting abroad might not invalidate a United States patent if application be filed within the time specified, provided that the invention "shall not have been introduced into public use for more than two years prior to the application." This provision was eliminated by the Act of 1897 and has never reappeared. Second, by the Act of

1903, Paragraph 2 of RS 4887 was added due to reciprocal arrangements with foreign countries. This paragraph primarily gives the "same force and effect" to the filing of an application in a foreign country as if the same application had been filed "in this country on the date on which the application for patent for the same invention, discovery or design was first filed in said foreign country" if the U. S. application is filed within twelve months of the filing date of the foreign application. However, it is important to note that in the last sentence of Paragraph 2, Congress modified the "force and effect" of the application filed in the foreign country so that the statutory bars relating to two years prior patenting or description in a printed publication before the actual filing of the application in this country, and "public use or on sale in this country for more than two years prior to the date of the actual filing" in this country still apply. Contrary to petitioner's contentions, Congress failed to include in this limiting portion of RS 4887 a further limitation which would preclude proof of facts relating to the actual date of an invention made in a foreign country to overcome the prior knowledge or use bar of RS 4886. The fact that, Congress, in limiting the "full force and effect" to be given to a foreign patent application omitted from its delineation of those bars not overcome by the foreign application all reference to the bar of prior knowledge or use is clearly indicative of its intent that no such additional limitation should be imposed. In other words, Congress did not in RS 4887 modify the plain intent of RS 4886—as clearly evidenced by its history as above pointed out.

RS 4887 as amended by the Act of 1903, which is substantially its present form, was dependent upon reciprocal relations with foreign countries. In discussing the matter on the floor of the House, (Congressional Record, Feb. 16, 1903, p. 2275) it was pointed out that:

"Nearly all of the nations which were represented there (International Convention for the Protection of Industrial Property, held at Brussels in December, 1900) have already passed the necessary legislation to give force to this act. I will read the names of the countries that have already legislated: Belgium, Denmark, France, Great Britain, Italy, Japan, The Netherlands, Norway, Portugal, Spain, Sweden, Switzerland, and Tunis."

It is of interest to note that at this same time an amendment was made to the old caveat law to permit citizens of any country in the world as well as citizens of the United States to file the proofs of their dates of invention in the secret archives of the government in order to rely on them to prove the same as may be necessary. Although the caveat section, RS 4902, has since been repealed and the factual dates are now proven as facts when proven in any case, it related to establishing priority rights to inventions prior to filing of formal applications for patent. In pointing out why this rule should apply to citizens of foreign countries as well as to citizens of the United States, Congressman Currier stated: (1903 Congressional Record, February 16, p. 2275)

"We do not discriminate against the citizens of foreign countries in regard to making application for patents, and no reason exists for discriminating against them in the matter of filing a preliminary application."

This preliminary application or caveat, constituted one manner of establishing an actual date of invention earlier than the filing date of an application.

Effect of R. S. 4892

Petitioner has vigorously contended that the patent statutes of the United States fail to take cognizance of acts of any nature which occur in a foreign country, other than those evidenced by patents, printed publications, or applications filed within the purview of R. S. 4887. However, in many instances the United States patent laws take full cognizance of occurrences in a foreign country. For example, R. S. 4892 requires that an applicant for patent "make oath that he does verily believe himself to be the original and first inventor . . . ; that he does not know and does not believe that the same was ever before known or used." There is no limitation as to place in respect of either of these allegations. Consider the situation where a citizen of a foreign country who makes an invention abroad has knowledge of a use of his invention either in his country or some country foreign to the United States prior to his earliest date of invention. Under such circumstances the foreign inventor would be unable to obtain a patent in the United States for his invention. He could not make the oath required under R. S. 4892. In this situation, although neither the inventor nor his invention nor the antedating prior knowledge and use thereof ever came within the territorial limits of the United States, the United States patent statutes would absolutely bar the granting of a patent. It was so held in *Spaulding v. Wanamaker*, 256 Fed.

530. Also see **Walker on Patents, Sixth Edition**, pages 115, 116. This is but one instance, many more could be cited but it is not deemed necessary to do so here.

Effect of R. S. 4920

The Fourth paragraph of R. S. 4920 authorizes the special defense that the patentee "was not the original and first inventor or discoverer of any material and substantial part of the thing patented." Reversely stated R. S. 4920 clearly indicates that to sustain a valid patent, the patentee must in fact be "the original and first inventor or discoverer" of the thing patented.

Petitioner tacitly admits that one of the statutory requirements is that a patentee must be the "first" inventor because it positively asserts (page 28 of its brief) that the patentee of the patents here in suit was not "within the meaning of those statutes, the first inventor of his alleged inventions." Hence, if under the statutes the patentee must establish that he is the "first" inventor to sustain his patent, he must be permitted to submit proofs to establish that fact.

It is respectfully urged, therefore, that the question of the propriety of the interference practice, either as conducted in the Patent Office or in the Federal Courts, in a contest of priority of invention between contestants for the same patent rights, is not before this Court, nor is a consideration thereof necessary to a determination of the issues between the parties here, particularly as the patentee Hall accepted limited claims after he was defeated on priority of invention by respondent.

**Respecting Certain of Petitioner's Contentions;
Respondents Submit That:**

The Nolan Act, referred to by petitioner, is not pertinent to the issue here involved. Under the recognized **interference practice** such an act was necessary. Moreover, its provisions are strictly limited thereto by the very wording of the act giving World War service men the benefits of acts done abroad insofar as they relate to "rights of priority with respect of said inventions" in "interference". The "other proceedings" referred to include suits under R. S. 4915 and R. S. 4918, involving interfering patents or interfering patent rights in contradistinction to the "interference proceedings", or the Patent Office practice in interferences.

Petitioner's argument page 17 of its brief that the denial of the effectiveness of foreign knowledge and use is in favor of the general public is offset by the fact that, supplementing the broader statutes, R. S. 4923 limits its application to the specific conditions recited therein, to-wit: that (only) wherever it shall appear that a patentee believed himself to be an original inventor, then and in that event to protect the "thing patented" the foreign knowledge and use shall not render such patent void under the conditions recited. Hence, the prohibition does not have any broader application or apply to the facts of the instant case as we have pointed out.

The suggestion that respondents' position here would lead to the conclusion that the amendment to R. S. 4887 would be a "work of supererogation" is unwarranted. Congress for the first time by the Amendment of 1903 gave the foreign application the same

force and effect as an American application would have as of the date filed in the foreign country. It is well known that one of the "effects" of the filing of an application in United States is a "constructive reduction to practice" of an invention described therein, but this is only one of the several important factors in establishing priority rights of invention such as conception, disclosure, etc. Before the Amendment of 1903, the written description in a foreign application was evidence of a conception, being a written disclosure of the invention. By the Amendment of 1903, Congress increased the legal effect of the filing of an application in a foreign country by giving it the effect of a "constructive reduction to practice" in contradistinction to its value prior to that Amendment as mere evidence of disclosure.

In **Ireson v. Pierce**, 39 Fed. 795, referred to in page 21 petitioner's brief, the plaintiff desired to rely upon a "provisional" British application, and the Court held that it could only admit a "complete" patent under the wording of the statutes referring specifically to R. S. 4923. No attempt whatever was made to show facts abroad such as actual reduction to practice, and hence a broad interpretation of the language used in the Ireson case makes it mere obiter dictum. Moreover, the real reason for the court's decision in the Ireson case is found in its statement that—

"It has been repeatedly held that an English patent does not exist as a patent for uses, under the sections of the Revised Statutes above referred to, until the enrolment or sealing of the complete specifications, at which time the English patent becomes open to the public."

Contrary to petitioner's contention, page 24 of its brief, that the lower courts herein overlooked the "broad purpose, object and spirit of the patent statutes", the history and plain intent of the pertinent statutes show that the courts below have merely given the foreign inventor the right afforded him under R. S. 4886 to show the actual and not artificial date of his invention in patent infringement suits against infringers. The only possible limitation to that right is R. S. 4923, where an American inventor is claiming the identical right to a patent for the identical invention which is not the case here.

Answering petitioner's argument on pages 26 and 27 of its brief, Hall kept his experiments secret and private until March, 1924, when he attempted to obtain a patent on this identical invention (as to certain claims) thus conclusively rebutting any presumption of an intent to donate it to the public.

Again, Shimadzu being the first inventor, as both lower Courts have concurrently held, Hall had nothing to "donate" to the public. Moreover, even if it were conceded that Hall had completed his invention in 1921, his dilatory procedure in waiting until 1924 to file his patent application exposed him to the eventuality which occurred here of another independent inventor (Shimadzu), first applying for patent, the grant of which made the knowledge available to the American public. Neither Hall nor petitioner did anything toward disclosing the inventions to the public during this period. Hence, if there are any evil consequences, petitioner and Hall brought them upon themselves.

Furthermore, petitioner through its engineer Hall attempted to obtain the exclusive rights for this identical invention for their own use, even provoking the interference with one of the patents in suit causing expensive patent interference litigation finally terminating in the defeat of Hall's claim to priority of invention. Now Hall and petitioner assert that their activities should be regarded as having been "donated" to the public. In "equity and good conscience" one should not be permitted to first proceed to attempt to obtain the patent rights for their own exclusive benefit, and then only after being defeated claim that these same activities invalidate respondents' patents. The concurrent fact findings of the Courts below that the testimony introduced antedates the alleged prior use set up by petitioner should not be disturbed unless plainly without "support" **General Talking Pictures Corp. v. Western Electric Co., et al.**, 304 U. S. 175. There is no doubt about the "support" in the instant case. The "support" was not only based on oral testimony as suggested by petitioner but by many clearly authenticated documents, such as PX-10, a drawing of December, 1918, notarized in Japan in September, 1919, as well as Ishimura's notebooks, PX-7 and 8, translations PX-7-A and 8-A.

It is important to note that **Ex Parte Grosselin**, 97 O. G. 2977, C. D. (1901) 248, cited on pages 21, 27, of petitioner's brief, refers to the cases relied upon by respondents such as **Hanifen v. Price**, 96 F. 435; **Hanifen v. Godshalk**, 78 F. 811; and **Welsbach Light Co. v. American Incandescent Lamp Co.**, 98 F. 613, and makes the same

distinction as that advanced by respondents here, to-wit: between Patent Office Interference and Patent Office Practice on the one hand and patent infringement suits against infringers in the Federal Courts on the other. In **Ex Parte Grosselin**, page 256, the Commissioner said:

"In the present case there is no question of an infringer, but merely the question as to the rights of the public to the invention after it has been put fully into its knowledge by publication."

Here there was no publication, whatever of Hall's alleged prior use.

Again, the two cases of **Vacuum Engineering Co. v. Dunn**, 209 F. 219, C. C. A. 2, and **Patents Selling & Exporting Co. v. Dunn**, 213 F. 40, C. C. A. 2, should be considered together. In the former, suit was brought on the Locke and Dunn patent, and the Schiodt patent was set up as a defense. Schiodt having made his invention in a foreign country, the Court held that under R. S. 4923 knowledge of the Schiodt invention abroad could not be used to defeat the Locke and Dunn patent. In the second of these cases suit was brought on the Schiodt patent, and having previously held in the first of these cases that Locke and Dunn were prior to Schiodt, the Locke and Dunn patent was treated as prior art to Schiodt. Thus these two cases again involved in effect a contest of priority between Locke and Dunn and Schiodt for the **same** patent rights. Here, Hall and petitioner are estopped from claiming Shimadzu's patent rights by reason of the amendment filed in the Patent Office by Hall accepting limited claims in the Hall patents. Hence the Dunn cases have no application here.

Respondents Position Is Not Based on a Mere Altruistic Theory that the United States Should Allow Persons All Over the World to Obtain Patents Here But, on the Contrary, By So Doing the American Public and Industry Has and Will Continue to Profit Thereby.

When R. S. 4886, or its predecessor, was amended to grant patents to citizens of any country of the world, of course it was not intended that patents so granted should have extraterritorial force as was attempted in **Brown v. Duchesne**, 19 How. 183, page 22 of petitioner's brief, where it was sought to enjoin infringement of a device on a foreign ship. But the United States patent statutes take full cognizance of many acts which occur in a foreign country. Thus, for over a hundred years, United States Patent Laws have contained a proviso making the validity of patents contingent upon whether or not the invention was described in any printed publication in any foreign country. Hence, description in a printed publication in any foreign country has always been regarded as a statutory bar, although the act of publication occurred in a foreign country. **Downton v. Yeager Milling Company**, 108 U. S. 466, 471, 477. **Rosenwasser v. Spieth**, 129 U. S. 47, 50, 52.

One of the purposes of our patent statutes is to permit foreign citizens to obtain valid patents in the United States and enforce them here.

Moreover, practically all of the countries of the world grant patents to United States citizens. Hence, because the population of the United States greatly exceeds that of the majority of those foreign countries, the benefits received by the public of this country, with

respect to any particular foreign country, greatly favors this country. The remark in Congressional Record, p. 2275, supra, supporting the amendment to R. S. 4887 extending the time within which a U. S. application may be filed, that "probably no people will be favored so much" as the "people of the United States" is apt as showing why no substantial objection was offered to the enactment of this amendment.

The provisions of the United States statutes for granting Commissions and Letters Rogatory and taking depositions thereunder, indicate that in many cases it becomes necessary in connection with rights enforceable in the United States to obtain evidence in foreign countries.

The theory upon which the United States allows citizens of foreign countries to obtain patents here is not a benevolent one. On the contrary, definite benefits result to the public of the United States. Inventions which otherwise might not have become known here, and possibly might not have been made, are thereby disclosed to the American public and after the seventeen-year term become public property. The introduction of foreign inventions here greatly aids American industry and tends to increase employment. Hence, the policy of our statutes is clearly to further that end, and bring new foreign industries here if possible. As one example of how foreign inventors have benefited the public of this country, great savings have already been effected in the manufacture of storage batteries in this country through the use of the inventions here in issue. For example, this record shows that respondents' licensees

are paying royalties, which represent but 25% of the total savings, at the rate of at least \$40,000.00 a year. This means that the savings in dollars and cents to the licensees (and in turn to the public of this country) have amounted to at least \$160,000.00 a year. Thus, over a fifteen-year period the savings resulting from the use of the inventions by one licensee would amount to at least \$2,400,000.00.

This is only one instance in the history of our patent system.⁶ There are many instances of where valuable inventions created in foreign countries which have been patented in the United States have proved of great value to industries in this country.

On the value of patents, this Court stated the principles of patent law as late as 1932 in **U. S. v. Dubilier Condenser Corp.**, 289 U. S. 178, 186, as follows:

"By Article 1, §8, clause 8 of the Constitution, Congress is given power to promote the progress of science and the useful arts by securing for limited times to inventors the exclusive rights to their respective discoveries. R. S. 4886 as amended (U. S. Code, Title 35 §31) is the last of a series of statutes which since 1793 have implemented the constitutional provision.

Though often so characterized, a patent is not, accurately speaking, a monopoly, for it is not created by the executive authority at the expense and to the prejudice of all the community except the grantee of the patent. **Seymour v. Osborne**, 11 Wall.

⁶ Actual count indicates that in the year 1937 over 4,900 patents were issued to citizens or residents of most important foreign countries by the United States.

516, 533. The term monopoly connotes the giving of an exclusive privilege for buying, selling, working or using a thing which the public freely enjoyed prior to the grant. Thus a monopoly takes something from the people. An inventor deprives the public of nothing which it enjoyed before his discovery, but gives something of value to the community by adding to the sum of human knowledge. United States v. Bell Telephone Co., 167 U. S. 224, 239; Paper Bag Patent Case, 210 U. S. 405, 424; Brooks v. Jenkins, 3 McLean 432, 437; Parker v. Haworth, 4 McLean 370, 372; Allen v. Hunter, 6 McLean 303, 305-306; Attorney General v. Rumford Chemical Works, 2 Bann. & Ard. 298, 302. **He may keep his invention secret and reap its fruits indefinitely.** In consideration of its disclosure and the consequent benefit to the community, the patent is granted. An exclusive enjoyment is guaranteed him for seventeen years, but upon the expiration of that period, the knowledge of the invention enures to the people, who are thus enabled without restriction to practice it and profit by its use. Kendall v. Winsor, 21 How. 322, 327; United States v. Bell Telephone Co., *supra*, p. 239."

It is Well Settled That a Domestic Inventor May Introduce Fact Testimony to Establish His Dates of Invention.

Since the Amendment of 1836, all Courts have consistently permitted the date of the invention of a patent-in-suit to be carried back of the date of such alleged defense. Thus, this Court stated in **Bates v. Coe**, 98 U. S. 31, 34:

"... the presumption in respect to the invention described in the patent in suit, if it is accompanied by the application for the same, is that it was made at the time the application was filed, and the complainant or plaintiff may, if he can, introduce proof to show that it was made at a much earlier date."

This Court also held in **St. Paul Plow Works v. Starling**, 140 U. S. 184, 198, that it was proper for plaintiff to introduce antedating testimony that "he had reduced the invention covered by his first claim to practice, in a working form" to antedate a defense, citing **Elizabeth v. Pavement**, 97 U. S. 126, 130 and **Loom Company v. Higgins**, 105 U. S. 580, 592, in which latter case this Court held Webster's patent valid over a defense of a prior use because of the antedating testimony presented by the patentee. In the recent case of **Barber v. Otis Motor Sales Co.**, 265 Fed. 675, 679, the Court stated:

"... it is well settled that, as against the statutory defense of anticipation, the patentee may show, if he can, the fact of his prior invention by drawings, sketches, models, or by any other competent proofs."

citing many of the above cases.

Conclusion Point I

Respondents are unable to summarize their views in respect of this point any more aptly than by quoting the following excerpt from an opinion by Judge Dallas in **Hanifen v. E. H. Godshalk, et al.**, 78 Fed. 811, wherein the Court stated:

"There is no statute which warrants the suggested distinction respecting inventions made abroad and those made in the United States. Section 4886 of the Revised Statutes enacts that 'any person who has invented or discovered any new and useful art, *** not known *** before his invention or discovery thereof, *** may *** obtain a patent therefor.' The right to a patent is thus made to depend, as to the point under discussion, wholly upon time of invention as related to then-existing knowledge, etc., and nothing whatever is said with respect to the place of invention. The learned counsel of the defendants have argued that it would be incongruous to permit a public use and sale abroad, more than two years before application, to save a patent by establishing date of invention, when such use and sale, if it had occurred in this country, would have operated to defeat the patent. A sufficient answer to this argument would be that the supposed incongruity is one which the law-making power has seen fit to create, but a more satisfactory one is that no dilemma whatever is really presented. There is no inconsistency between the substantive law which provides that a foreign public use shall not, in itself, invalidate a patent, though a similar use and sale here would do so, and the law of evidence under which such foreign use and sale may be shown to fix date of invention. The same evidence which for one purpose would be inadmissible may for another be competent. An offer to prove public use and sale in a foreign country more than two years before the filing of the application would, if made to invalidate a patent, be manifestly irrelevant, for the reason that it could not have that effect but a like offer, if made to show date of inven-

tion, would, quite as manifestly, be relevant, because it might, at least, tend to establish it. If there is anything in this state of the law which is extraordinary, I fail to perceive it. Several decisions of the Patent Office, extending from 1872 to 1888, have been examined. They show a consistent view of the law to have been there adopted and established, from which I certainly would not dissent without much hesitation and very full consideration. But those decisions do not relate to the precise question which is now before the court, and will not be affected by the conclusion which I have reached respecting it. They were all enunciated in interference proceedings ***

In other words, what has been held is that the single fact of previous invention in the United States is but that mere previous invention in a foreign country—i. e. without patent or printed publication—is not a bar to the grant of a patent; but it has not been held that, where an uncontested application is founded upon invention abroad, the grant of a patent is invalid if a sufficiently remote date of invention cannot be established without acceptance of the time when the invention had been made in a foreign country; and it seems to me that, while the actual rulings of the Patent Office conform to the law, they could not, without conflicting with it, be made applicable to the present subject. They are supported by the terms of Section 4923, but the inference now sought to be deduced from them is quite as plainly inhibited by Section 4886. Thomas v. Reese, 17 O. G. 195; Hovey v. Hupland, 2 O. G. 493; Chambers v. Duncan, 10 O. G. 787; Lauder v. Crowell, 16 O. G. 405; Rumpff v. Kohler, 23 O. G. 1832; Boulton v. Illingworth, 43 O. G. 508.

"I know of no case in which this point can be said to have been judicially determined. I believe it was not argued, and am sure it was not investigated by the Court, in Uhlman v. Brewing Co., 53 Fed. 485. That case seems to have been presented as one of conflict between two patents, and in such manner as to direct attention only to the inquiry whether the Stockheim or the Klein invention was first known or used in this country.' It appears to have been assumed that the inquiry stated was in that case the material one, and the particular question which is now for solution was, apparently, not then discussed, and certainly was not considered. Reference has been made to several opinions delivered by Judge Coxe, but which, when read together and in connection with the observations made upon them by the Court of Appeals for the Second Circuit, do not, I think, indicate that the view of the law which I have expressed is at variance with that which is entertained in that jurisdiction.

In Electrical Accumulator Co. v. Julien Electric Co., 38 Fed. 117-128, Judge Coxe said:

'The evidence of prior invention by Charles F. Brush is now to be considered. In determining this question, Faure, being at that time a citizen of France, is not permitted to claim the invention earlier than the date of his French patent, which was October 20, 1880,' etc.

"The learned judge did not state the ground on which he rested this proposition, and cited no authority for its support. The gist of it seems to be that Faure's French citizenship (not the place of invention) precluded him from claiming his invention as of a date earlier than that of his French

patent; but, in the absence of explanation, I infer that it was Section 4923, and not Section 4886, which was in contemplation, and that what was really meant is that, under Section 4923, the patent of Brush should not be held to be void on account of prior invention in a foreign country, 'if it had not been patented.'

"Thus it appears that the Circuit Court and Court of Appeals both regarded as an important circumstance the fact that Brush was an original inventor and a patentee; and there is no difficulty in reconciling the ruling that, as against such a party, prior invention abroad, without patent or publication, is of no consequence (Section 4923), with the position that as against one who is neither an inventor nor a patentee, but an infringer, the owner of a patent may show that the invention was made, though in a foreign country, at a time when it was not known or used in this country, nor patented or described in any printed publication in this or any foreign country (Section 4886).

"I have reached the conclusion that it was competent for the complainant to prove the actual date with reference to invention made in England;"

See also—

Hanifen v. Price, 96 F. 435

Welsbach Light Co. v. American

Incandescent Lamp Co., 98 F. 613

Badische Anilin & Soda Fabrik v.

A. Klipstein & Co., 125 F. 543

Claude Neon Lights, Inc., v. Rainbow
Light, Inc., 47 F. (2d) 345.

From a consideration of the foregoing history of the patent statutes and of the authorities cited, it is mani-

fest that petitioner's contention with respect to the issue presented under Point I is untenable. This issue is controlled by R. S. 4886. The language of that Section is clear and unambiguous. Under the present wording of the statute, in the absence of any limitation upon the place of discovery or invention, respondents are clearly entitled to rely on the real date of Shimadzu's invention irrespective of the fact that his inventive acts occurred in a foreign country.

POINT II

- (1) **Suppression and Concealment of Invention Were Neither Pleaded by the Petitioner in the Answer nor Urged Before Either the District Court or the Circuit Court of Appeals; Therefore Such Alleged Defenses Not Properly Before This Court.**

No such defense is found in the Answer, nor elsewhere in the record, nor was it advanced during the trial nor on the arguments nor in the briefs before the District Court. It was not argued in the Circuit Court of Appeals nor mentioned in petitioner's briefs before that Court. It cannot properly be raised *de novo* in this Court. No testimony was taken by petitioner directed toward such a defense. After Shimadzu and his witnesses had been examined in Japan and voluminous testimony taken on the trial without any such defense having been raised, it is clearly inequitable for respondents to

have to meet such a question for the first time in this Court, especially where this belated plea by a petitioner relates to facts particularly within the knowledge of respondents. Had respondents been properly put on notice, adequate rebuttal testimony could have been introduced. It is too late for petitioner to raise it now. Such procedure was condemned by this Court in **Rubber Company v. Goodyear**, 76 U. S. 788, 801, where this Court stated referring to a belated plea in a patent case:

"The answer of the defendants is as silent upon the subject as the bill of the complainants. No such issue was made by the pleadings. It was too late for the defendants to raise the point before the master. They were concluded by their previous silence, and must be held to have waived it. It cannot be considered here."

(2) In any Event the Record Fails to Show any Suppression or Concealment by Shimadzu of His Inventions During Which any Intervening Rights Accrued So as to Warrant Invalidating His Patents.

Had this defense been pleaded, the burden would have been upon petitioner to establish it. This, petitioner has not done. In fact, the evidence directed to other phases of the case shows conclusively that there was no such suppression or concealment.

After his reduction to practice in August, 1919, Shimadzu proceeded immediately to install new mills, a new plant, and was continually improving the commercial and economical efficiency of his process, and the effect of the various elements of his operations. (R. II, 1140) (PX-7A and 8A). Shimadzu states (R. II, 1138):

"Finally, in June, 1920, my superhuman effort was rewarded materially. The batteries made from my product were high in dependability and long in life."

Respondent's first United States application (PX-39) was filed in December, 1920, and refers to pulverizing metallic lead into a fine powder by "mechanical means". Obviously, in view of all the testimony of record the "mechanical means" referred to is the rotating drum used by Shimadzu in 1919 and in the new plant set up by June, 1920 (R. II, 1140). In an extensive amendment filed in the United States Patent Office July 18, 1922 (PX-39) Shimadzu disclosed various features of the '150 patent.

In view of this fact, the United States Patent Office permitted Shimadzu to state in the application for '150 patent that it was a continuation of the earlier 1920 application (PX-39). This Court stated in **General Talking Pictures Corporation v. Western Electric Company, Inc., et al.**, 304 U. S. 175, 183:

"The effective dates of the claims of the continuation applications are those of the original applications."

On this basis, as to common subject matter, the effective filing date of the '150 patent is December, 1920.

Application No. 431,473 filed December 17, 1920, was co-pending and over-lapping with application for patent No. 1,584,149, filed January 30, 1922, which in turn was pending at the time of the filing of application for patent No. 1,584,479, filed February 20, 1923, and patent No. 1,584,150 filed July 14, 1923. The

inventor was a Japanese, living more than 6,000 miles away. The subject matter of his invention had to be translated, mailed to this country to a patent solicitor, adapted to our patent practice, with time required for correspondence between the solicitor and his client, and then filed in the Patent Office. Diligence, rather than lack of diligence, is conclusively shown. Certainly such activity by a foreign inventor cannot be described as any deliberate suppression or abandonment of the inventions.

As to Shimadzu's activities, the record shows that Shimadzu stated (R. II, 1140):

"From June, 1920, on I was performing experiments in the newly built lead powder factory, producing at the same time for commercial purposes."

* * * * *

"In 1922 I began exact qualitative analysis of the product."

On Page 1144 of the record Shimadzu states:

"After I started the experiments on the making of the lead powder I partly completed the process in the spring of 1919, and in 1920, when I almost completed the industrial process."

On Page 1148 of the record Shimadzu testifies as follows:

"Now, any invention takes a great deal of time and energy. In order to complete the invention, first an idea is formed in the inventor's mind; it undergoes stages of mental development. Then it materializes, then it is made into a model in crude form, and requires many improvements and years of hard work."

There is no evidence that Shimadzu was spurred into activity by reason of any intervening rights of third parties. He was a pioneer in solving the problem in this long-sought art, which the industry throughout the world had been trying to solve.

There is absolutely no claim that any knowledge of petitioner's activities was communicated to Shimadzu directly or indirectly (R. II, 1163, 1177, 1179). If anything, the record suggests that petitioner, through its engineer, Hall, was spurred into activity by knowledge of Shimadzu's inventions disclosed in chemical publications to which it subscribed in the early part of 1924 (R. II, 1038, 1039). If public use of the inventions by petitioner and Hall commenced in June, 1921, why was Hall's application for a patent not filed until March 29, 1924, and why did Hall, at that time, swear that the inventions were not in "public use" if his experiments were not strictly "private"? During this period Shimadzu filed his applications for United States patents. If any estoppel is to be applied it should be against the petitioner. In fact, the record affirmatively shows that the public of the United States actually derived the benefit of the inventions from Shimadzu.

The concurrent decisions of the courts below resolve this issue in respondents' favor and it is therefore not properly a question for review here on certiorari. **General Talking Pictures Corp. v. Western Electric Co.**, 304 U. S. 175, 178, 179.

The case of **Kendall v. Winsor**, 21 How., 322, 328, cited by petitioner is in accord with the decisions below. In that case this Court stated:

"But the relation borne to the public by inventors, and the obligations they are bound to fulfill in order to secure from the former protection, and the right to remuneration, by no means forbid a delay requisite for completing an invention, or for a test of its value or success by a series of sufficient and practical experiments; nor do they forbid a discreet and reasonable forbearance to proclaim the theory or operation of a discovery during its progress to completion, and preceding ~~an~~ application for protection in that discovery. The former may be highly advantageous, as tending to perfecting the invention; the latter may be indispensable, in order to prevent a piracy of the rights of the true inventor."

The evidence showed that there the inventor constructed a machine in 1846 and several in 1849, which were used in trade until the patent therefor was applied for in 1854, an interval of at least five years. Moreover, in that case the inventor deliberately announced that he proposed to maintain the invention a secret and tried to do so, this Court stating in that case, p. 324, that the inventor

"repeatedly declared to different persons that the machine was so complicated that he preferred not to take a patent, but to rely on the difficulty of imitating the machine, and the secrecy in which he kept it."

It is indicated in the opinion that the inventor would never have filed an application had he not learned that a competitor had duplicated his machine. For nine years, the patentee in that case had attempted to maintain the inventions secret. This Court approved the charge of the lower Court to the jury, in effect, that to

constitute such abandonment to the public by concealment as will destroy the inventor's right to a patent, where no sale or public exhibition has been made, "the jury must find that he intended to give up and relinquish his right to take letters patent". Finally this Court held that the question was one of fact and peculiarly within the province of the jury, and approved the charge to the jury (p. 331) which found that the inventor was entitled to his patent.

The quotations from the other cases referred to by petitioner are not helpful unless the facts are shown. Thus:

In **Wirebounds Patents Co. v. Saranac Automatic Mach. Corp.**, 65 Fed. (2d) 904, suit was brought on a method patent which was issued on a divisional work-holder patent application which had been filed October 14, 1904. No method claims were filed at that time nor until 1912 in a divisional application. The interferences in the Patent Office were only on machine patents and had nothing to do with a method or process, and it was held that they were no excuse for delay in presenting claims to the method or process.

In **Victor Talking Machine Co. v. Starr Piano Company**, 281 Fed. 60, the original application was filed by Johnson August 16, 1898. The patent actually in suit came from a divisional application in the Patent Office which was not filed until 1904. In the meantime one Jones had taken out a patent based on application filed in November, 1897. Johnson, thinking the particular part of his invention invalid, for years kept his process secret, and the Court held there was an abandonment under the decisions.

In **U. S. Rifle and Cartridge Co. v. Whitney Arms Co.**, 118 U. S. 22, an inventor's application for patent was rejected and withdrawn by him. Without substantial reason or excuse he omitted for eight years to reinstate or renew it, during which time many patents embodying the substance of the invention were granted to others. Naturally the court held there was an abandonment.

In **Webster Co. v. Splitdorf Co.**, 264 U. S. 463, the original application was filed February 2, 1910. On June 17, 1918, although the application had been pending since 1910, the claims in suit were presented after more than eight years' delay. "During all this time their subject matter was disclosed and in **general use**," this Court so stating in that case, page 465. After such **general use**, the patentee brought forward **broader** claims than those originally sought, attempting to thus **expand** his original invention. No such facts are present here.

In **Woodbridge v. U. S.**, 263 U. S. 50, the inventor, after allowance of patent, procured the papers to be filed in the secret archives, and for nearly ten years deliberately abstained from requesting issuance of patent in order to postpone the beginning of the patent monopoly. This was a clear case of abandonment by conduct.

Clearly, Shimadzu did not suppress, conceal or withhold his inventions to the detriment of any person in the United States so as to now be estopped to enjoy fully the rights granted him.

POINT III

The Concurrent Holdings by the Courts Below of Validity of the Patents in Suit Should Not be Disturbed Irrespective of Petitioner's Alleged "Public Use".

- (1) Admittedly there can be no such defense against Patent No. 1,584,149.**

Patent No. 1,584,149 was applied for on January 30, 1922. The earliest date on which commercial (not public) production may have been begun by petitioner is June, 1921, a little more than six months before No. 1,584,149 was applied for. Petitioner's process was found to infringe this patent and a decree for an injunction and accounting made. Clearly, therefore, petitioner's alleged public use cannot affect this patent because such use is not claimed to have commenced more than two years prior to the filing of the application therefor.

- (2) The Defense of Alleged Public Use was not Properly Pleaded and Therefore that Question is not Open In This Court.**

Notwithstanding petitioner's discussion of the pleading in its brief, pgs. 34-36, it is pointed out that no "public" use by defendant is affirmatively alleged in the Answer as required by RS 4920.

In fact, petitioner was careful not to allege in its answer (R. I. 35) that the inventions had been in public use for more than two years prior to respondents' patent applications. Petitioner relies, however, on respondents' allegations and its alleged denials. An examination, however, of the pertinent paragraphs of the

pleadings reveals that petitioner in answering allegations of paragraphs 5, 7 and 15 of the Bill of Complaint (R. I, 8, 9, 14) denied knowledge of its alleged public use. For example it alleged in paragraph 5 of its Answer (R. I, 38) as follows:

"5. Answering Section 5 and 6 of the bill, defendant admits that one of the patents in suit, No. 1,584,150 was granted on the 11th day of May, 1926, but is **not informed** except by the bill of complaint as to the truth of the other allegations (among them the allegation of lack of two years prior public use) thereto made and therefore denies the same and denies that said patent was duly or properly issued or granted."

It is thus clear that what petitioner here alleged was that it was not informed as to the allegation in the bill that there was no two-year prior public use. It cannot now claim that its own use constituted a two-year prior public use, in view of the allegation that it was not informed as to such use. Certainly, if its own use is the public use relied upon, it could not say that it was **not informed** as to it.

Under the provisions of R. S. 4920, the defense of public use is a special defense which must be specifically pleaded by a defendant. Failure to comply with such statutory prerequisite therefore prevents the petitioner from urging this belated defense. **Angle v. Richardson**, 19 Fed. Supp., 1002, 1004; **Abrahams v. Universal Wire Co., Inc.**, 10 Fed. (2d) 838, 842; **The Byrne Manufacturing Company v. American Flange & Manufacturing Co., Inc.**, 58 Sup. Ct. 18. The reason for this rule is sound. Respondents, in view of the pleadings, had no occa-

sion on the trial to examine petitioner's witnesses or to offer independent testimony on an issue not in the record, which they otherwise might have done had they been properly apprised of such a defense. Likewise, this question was not urged on the trial, nor was it urged in the numerous briefs filed by petitioner, until after the District Court's decision, referring to the "commercial production by the Hardinge Mill." Petitioner unsuccessfully raised this defense for the first time in the Circuit Court of Appeals. Therefore, to entertain this belated plea now would work a gross injustice upon respondents.

Rubber Co. v. Goodyear, supra.

Petitioner claims in its brief (p. 35) that respondents did not object to petitioner's answer on the ground of inadequacy or object to any testimony that its alleged use of its process was a public use. But how could respondents object on the ground that the answer did not plead two years public use if the petitioner elected not to so plead, and how could it object to any testimony that such use was "public" when there was no such testimony? The reasons why petitioner neither pleaded nor proved that the inventions in question were "in public use for more than two years prior" to the applications are obviously because such pleading and proofs would have invalidated Hall's own patents No. 1,675,345 and 1,888,823 under which petitioner was operating (R. I, 59), and that Hall activities were not considered by petitioner as public use.

- (3) Both Lower Courts Having in Effect Found that the Inventions of the '150 and '020 Patents Were not in Public Use Within the Meaning of RS 4886 by Holding Said Patents Valid Have Resolved a Question of Fact in Respondents' Favor Which has Unquestionable Support by the Record and Should not Be Disturbed Here.

It is too obvious for extended argument that both Courts resolved this question of fact in respondents' favor. There is no finding of such public use. The concurrent holdings reached by both Courts below were that the patents in suit are valid. Hence the familiar rule applies, and it is respectfully submitted that this question of two-year public use having been decided concurrently below in favor of respondents should not be disturbed here, unless clearly without support (which is not the fact here). **See General Talking Pictures Corp. v. Western Electric Co., et al.**, 304 U. S. 175,⁷ where this Court indicated that a decision against a "public use" was a fact finding, stating, 182, 183:

"The District Court and Circuit Court of Appeals found that there was no public use of either of the inventions of the first two patents prior to the filing dates of the divisional applications upon which they issued. These findings were made upon adequate evidence . . ."

Moreover, this Court in the same case, page 178, stated:

⁷ See also such cases as: **Thomson Spot Welder Co. v. Ford Motor Co.**, 265 U. S. 445; **St. Paul Plow Works v. Starling**, 140 U. S. 184, 196; **Coupe v. Royer**, 156 U. S. 565, 577; **Bischoff v. Wethered**, 9 Wall. 814.

"Whether respondents acquiesced in this infringement and are estopped depends upon the facts. Granting of the writ would not be warranted merely to review the evidence or inferences drawn from it. Southern Power Co. v. N. C. Public Service Co., 263 U. S. 508; United States v. Johnston, 268 U. S. 220, 227. Moreover, the decision on that point rests on concurrent findings. They are not to be disturbed unless plainly without support. United States v. Chemical Foundation, 273 U. S. 1, 14. United States v. McGowan, 290 U. S. 592. Alabama Power Co. v. Ickes, 302 U. S. 464. There is evidence to support them."

- (4) **There is Ample Evidence to Support the Concurrent Findings Below, in Fact the Record Clearly Establishes that the Inventions in Suit Were not in Public Use for More Than Two Years Prior to the Actual Filing of the Application for the '150 Patent nor for the '020 Patent Which is Entitled to the Same Filing Date.**

This defense must be proven by clear convincing evidence "beyond a reasonable doubt", **Eibel Process Co. v. Minneapolis & Ontario Paper Co.**, 261 U. S. 45. Respondents respectfully submit that not only is the defense not proven, but the concurrent findings below against such defense are clearly supported by the record. The Courts below indicated that an essential feature of the Shimadzu inventions is the production of a suitable battery compound on a commercial scale. Thus, the Court stated (R. II, 1164) that—

... some process by which the right kind of powder could be produced in trifling amounts was of very little value to anyone. The industry was looking

for a way to make large quantities cheaply, and an invention which fell short of accomplishing that result would have been of academic interest only."

Again, the Court in showing how the Tudor Mill was unsuccessful, pointed out (R. II, 176) that it did not "meet the requirements of a commercially useful process." Hence, the Court's use of the word "commercial" was merely to distinguish between an operation conducted on a commercial scale in order to determine its economic value from one conducted on a laboratory scale. No thought that the operation was of a "public" nature is even remotely intimated. Petitioner's experiments during this period were with a "second-hand" 5-foot Hardinge Mill (R. I, 468) in contradistinction to the 6-foot standard production mills set up in petitioner's new plant at Crescentville in 1923, with respect to which the witness Smith stated "that in July, 1923, production of Gray Oxide began" (R. I, 466).

The word "public" is defined in Webster's New International Dictionary, Second Edition, Unabridged, as follows:

"... of or pertaining to the people, relating to, belonging to, or affecting, a nation, state, or community at large—opposed to private; . . ."

Thus, "public" is used in antithesis to "private." A "commercial" use might be either "public" or "private" depending on the facts. In the instant case it was certainly private. The record fails to show that a single member of the public had access to this experimental work conducted by defendant's employees. In fact, petitioner's witness stated (R. I, 499) that—

"On rare occasions, we do let people in to see these mills in the plant now."

In other words, at the date of giving the testimony (1935), long after Hall's patent had been issued, petitioner permitted outsiders "on rare occasions" to see the mills, but there is no evidence of any such admission of outsiders even "on rare occasions" during the critical period.

The record implies that in 1921 the powder produced by this mill was not actually used in production, although produced by the experiments on a commercial scale. Thus, when called upon to state what percentage of petitioner's requirements was produced by the Hardinge Mill, no figures whatever were given for any part of the year 1921, notwithstanding that the "critical date" is July 14, 1921, for the two-year period. This failure must be resolved against petitioner. Public use requires that the use be primarily in the ordinary channels of trade. As petitioner has shown no production for the year 1921, it has thereby conclusively rebutted its allegation of public use during that period.

Again, the record does not show any sale of any product to the public. When this lead dust was produced by the Hardinge Mill, petitioner's department of development and design issued a special process, No. 5065, for battery tests purposes (R. I., 465) the last sheet being dated October 26, 1922. The witness Smith introduced DX-68 as an illustration thereof and at the top printed in large letters are the words "Experimental Shop Process." Hence, according to petitioner's own witnesses and documentary evidence, the activities up until October, 1922, were regarded as experimental.

Moreover, petitioner's policy of secrecy is also shown by the necessity of a court order for inspection of its process. Petitioner objected to any of respondents' engineers entering the plant. The appointment of a special expert by the Court was necessary before respondents could ascertain anything about petitioner's present-day practice.

Moreover, in the interferences Mr. Hall in October, 1928, testified (PX-41, p. 55):

"X-Q. 127. Would you mind showing us one of those mills that the Electric Storage Battery is now using?

"Mr. Stoughton: That is a question that you may or may not, as you please, refuse to answer unless and until ordered by the Court to do so.

"A. I am not going to show these mills."

(5) There Is No Proof of Public Use of the Process as Distinguished From the Product.

The claims here involved are for a process and a machine, not for a product. The finding that the petitioner used the product when the public did not see the process will avail the petitioner naught. The record is barren of any evidence that the public ever saw or knew the process during the critical period.

As an indicia of "public use", petitioner claims that certain employees familiar with its process left its employ under no pledge of secrecy in 1916 and 1918, long prior to the installation of the Hardinge Mill (R. I., 539). Respondents' witness Cooper did not enter the employ of the petitioner until June, 1923 (R. I., 401). Thus, Cooper stated (R. I. 401):

"I went to work for them (petitioner) in June, 1923, and left there some time in the year 1930."

There is no evidence when Nagle entered or left its employ. The knowledge of such employees therefore could have no bearing on the question of "public use" subsequent to June, 1921, and prior to July, 1923. The record fails to show that even such employees left without pledge of secrecy. In any event, even if petitioner's employees were under no pledge of secrecy, that fact alone would not establish public use.

Each case involving a "public use" issue must stand on its own peculiar set of facts. In interpreting this statutory bar, it is well settled law that use even in public, whether on a commercial or laboratory scale, if primarily for test purposes in order to ascertain the "utility, value or success of the thing invented by patentee," will not defeat the patent. The basic case for this doctrine is **Elizabeth v. Pavement**, 97 U. S. 126, 134, 135, where this Court stated:

"The use of an invention by the inventor himself, or of any other person under his direction, by way of experiment, and in order to bring the invention to perfection, has never been regarded as such a use.

* * * * *

"When the subject of invention is a machine, it may be tested and tried in a building, either with or without closed doors. In either case, such use is not a public use, within the meaning of the statute so long as the inventor is engaged, in good faith, in testing its operation. He may see cause to alter it and improve it, or not.

* * * * *

"Whilst the supposed machine is in such experimental use the public may be incidentally deriving a benefit from it. If it be a grist-mill, or a carding-machine, customers from the surrounding country may enjoy the use of it by having their grain made into flour, or their wool into rolls, and still it will not be in public use, within the meaning of the law."

Moreover, if the use of the patented article is for experimental purposes, the period within which the application must be filed does not run until the experimentation ceases **Cline Electric Mfg. Co. et al. v. Kohler**, 274 Fed. (2d) 638, certiorari denied, 49 S. Ct. 82.

The alleged prior public use relied upon by petitioner, is the identical work of Hall, petitioner's engineer, which formed the basis of Hall's application filed in March of 1924, and as we shall point out, Hall was engaged "in good faith in testing its operation."

When an application for patent is filed, the inventor under RS 4888 must not only explain the principle thereof, but give "the best mode in which he has contemplated applying that principle." Hence, it is obvious that before Hall, petitioner's engineer, could properly do so, it was necessary for him to make the tests of the nature referred to by this Court in **Elizabeth v. Pavement**, supra. Bearing in mind that petitioner has in effect admitted (R. II, 1032) that it obtained no production from the second-hand Hardinge Mill (R. I, 468) for the year 1921, and that in the lower Courts' view, the inventions here required tests on a commercial scale as being of "the essence of the invention" as stated above the facts of the record clearly bring the instant case within the doctrine of the Elizabeth case. It is

therefore clear that the lower Court, in not finding "public use" against any of the patents in suit, reached conclusions both concurrent and correct, and supported by the record.

Briefly reviewing the record on this score, we again find that support in the evidence. Petitioner's uses were clearly experimental from June, 1921, on until the end of that year and in fact until 1923 when standardized machines were bought (R. I. 466).

Petitioner's own witnesses establish that there were several factors "vital" to the success and the commercial operation of the alleged invention. Thus, Smith states that matter of load was "vital" (PX-41, p. 453). The load (or amount of charge in the drum) used by petitioner in the experimental use at first was under 14,000 pounds (R. I. 515). However, in September, 1921, two months too late to have any effect on the patents in suit, this load was increased to 19,000 pounds (DX-61, sheet 1 of 9-26-21 test). This is the amount referred to in Hall's patent application filed in 1924 and is the amount now used. Such substantial variation in the amount of lead charged into the mill indicates the primarily experimental nature of the operation. Although talking about a duplicate of the Hardinge Mill, petitioner's witness Smith also stated:

"It has been found that that matter of charging the mill is also a very vital point in its operation. It must be charged correctly, and by charging too much I suspect they interfered with the operation so as to make it, as we have said, commercially unsuccessful."

However, petitioner did not revert to the load of 15,000 pounds of June, 1921, but continued to improve the other factors so as to be able to use the 19,000-pound load of September, 1921.

Again, the "percentage of oxidation" was also described as vital. Petitioner's witnesses state that the "low oxidation" material had no commercial utility whatever and had to be abandoned. Thus, Hall, stated (R. II, 1025) "I never said I used that low oxidation stuff commercially" also specifying "The low oxidation is made for experiments." As to the use of the "low oxidation" powder, Hall also stated (R. II, 1027):

"I made plates out of it, but they just weren't worth a whoop, and we had to throw them all out."

These experiments were subsequent to the critical date. In June, 1921, the percent oxidation was between 57% and 68% (DX-60). Yet in August, petitioner's engineer increased the percentage oxidation to 86% (DX-62). In September, 1921, however, the oxidation was reduced to 44 to 51%, the very lowest percentage of any of petitioner's tests (DX-61). Presumably, this was the "low oxidation powder" which Hall stated he did not use. (R. II, 1027). In October it attained a high of 71% (DX-64), while in December it was reduced to an average of 67% (DX-63), the average finally adopted.

Considering a third vital factor, at no time during this 1921 period did the amount of air exceed 33 cubic feet per minute, the maximum capacity of the fan then employed (DX-43). The air was reduced from a value registered as 1.70 in September (DX-61) down to .25 in

December (DX-63) although it later turned out that a vastly larger blast of air than used in any of these tests was required.

Considering now these same factors as set forth in Hall's application filed in June, 1924, we find further important changes as compared with the early experiments in 1921. The amount of air was increased from a maximum of 33 cubic feet per minute in 1921 to 150 cubic feet per minute, an increase of about 500% in 1924. The load instead of being the 15,000 pounds used in the experiment of June, 1921, was 19,000 pounds in 1924. The temperature was specified as high as 375° in 1924 compared with 275° of the 1921 "commercial" experiments—an increase of 32%. Petitioner's present practice is still further removed from the 1921 experiments.

From the foregoing it is evident that the lower Courts were correct in not finding that the invention in question had been in "public use" in this country for more than two years prior to the patentee's applications.

(6) Hall's Oaths in His Patent Applications and Preliminary Statements Executed Prior to this Litigation Estop Defendant From Claiming "Public Use" Based On Identical Activities Referred to in Said Oaths.

In Hall's application (PX-18), Hall swore that the very apparatus and process now alleged to constitute the "public use" had not been in public use or on sale more than two years prior to the filing of his application in March, 1924. As the "critical date" for this alleged two-year public use defense against the '150 and '020 patents is July, 1921—two years prior to the

United States filing date for the '150 patent—this alleged defense of public use completely fails. Hall likewise made similar oaths in his preliminary statements in the Hall-Shimadzu Interference, (PX-41, pp. 13, 14, 18). These three oaths were made long prior to the present controversy and so have much greater weight than the oral testimony of witnesses at the trial. In fact, no witnesses at the trial testified that the inventions here in issue were in "public use." Hall, who should know the facts the best of any of the witnesses, although examined as a witness by petitioner on the trial, was not called upon to testify with respect to any such "public use." Under familiar rules of evidence, it must be assumed that if he had testified on this point, his testimony would have been unfavorable to petitioner. Respondents submit that these three oaths by Hall that the inventions in question were not in "public use" conclusively rebut petitioner's present contention that Hall's early activities constituted a public use of the inventions in suit and that petitioner—being in privity with Hall—is estopped from asserting the same. Petitioner stipulated (R. II, 780):

"... that defendant paid the expenses of the Interference proceedings between Hall and Shimadzu, the record of which is marked Plaintiffs' Exhibit 41."

Moreover, under Rule 126⁸ of the Rules of the United States Patent Office, during the pendency of

⁸ For the convenience of the Court, Rule 126 of the Rules of Practice in the United States Patent Office is set out in full in the Appendix.

the interference, if the Examiner of Interferences or the Board discovers any grounds in the testimony which "amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference" it is his duty to call the attention of the Commissioner of Patents to the same, whereupon the Commissioner may suspend the interference and reject the claims. It frequently arises that the testimony taken in an interference shows a public use. In the instant case, no such recommendation was made by any of the tribunals of the Patent Office passing on the record. This raises the clear presumption that those tribunals did not regard these experimental tests as amounting to a "public use" within the meaning of the statutes, or to "constitute any statutory bar" as referred to in Rule 126.

CONCLUSION

From the foregoing, the concurrent findings of the Courts below holding patents 1,584,149, 1,584,150 and 1,896,020 valid and infringed are correct and should be sustained. Respondents clearly had the right to introduce the foreign testimony to antedate petitioner's alleged prior use. Patent 1,584,149 by reason of the filing date of the application therefor in the United States is not in any way affected by petitioner's Points II and III. The concurrent holdings of the Courts below, in effect resolving in favor of respondents any alleged defenses of public use, and concealment and suppression affecting patents 1,584,150 and 1,896,020 are clearly correct and should be sustained.

The decree of the Court below should be affirmed or, in the alternative, the Writ of Certiorari should be dismissed.

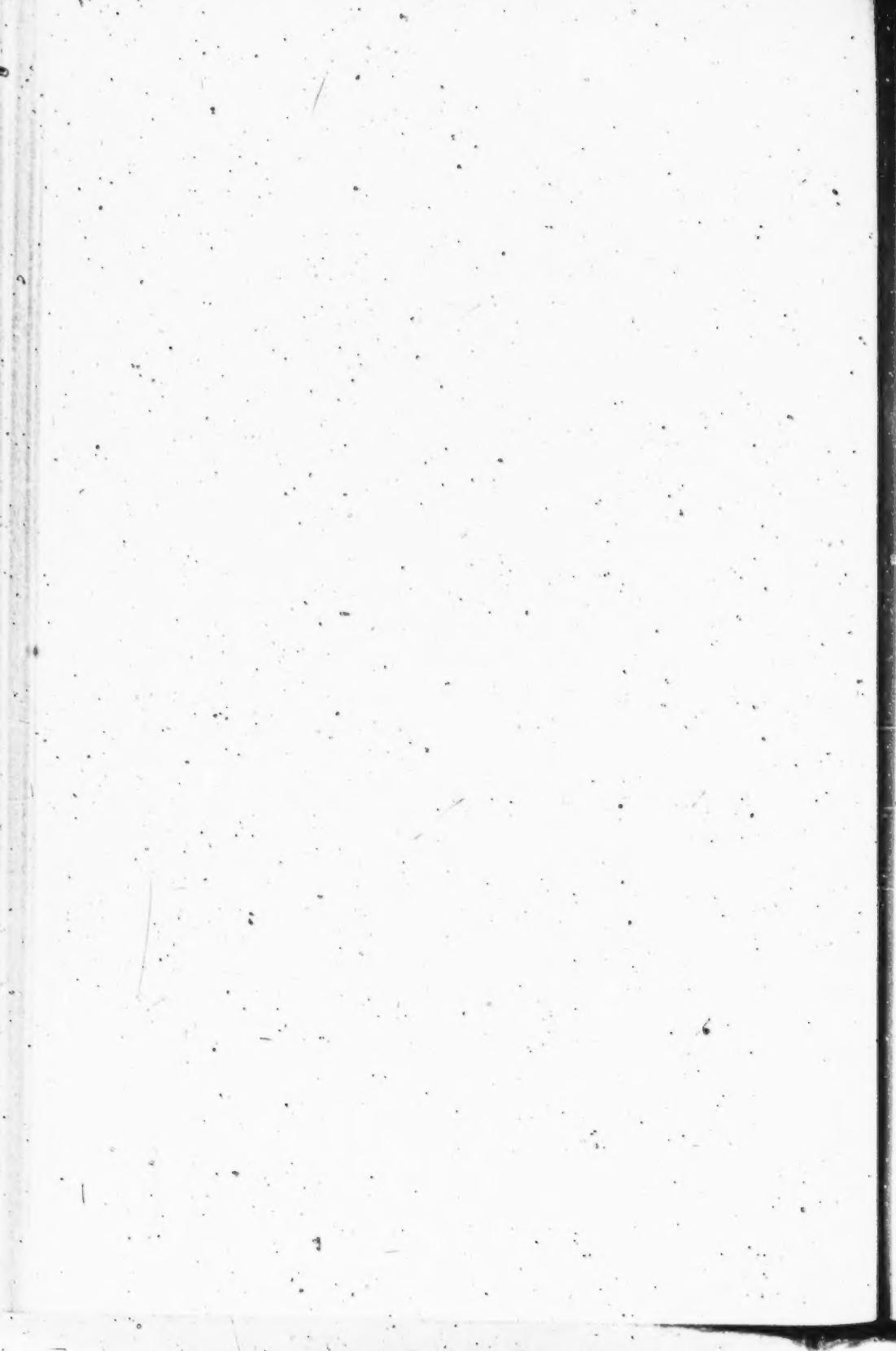
Respectfully submitted,

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Dated: January 27, 1939



A P P E N D I X

	Page
R. S. 4886 Section 31. Inventions Patentable	1-a
R. S. 4887 Section 32. Inventions Previously Patented Abroad	1-a
R. S. 4892 Section 35. Oath of Applicant	2-a
R. S. 4920 Section 69. Pleading and Proof In Actions for Infringement	3-a
R. S. 4923 Section 72. Patent Not Void for Previous Use of Thing in Foreign Country	4-a
Rules of Practice in the United States Patent Office	
Rule 126	5-a
Statutory History of R. S. 4886	6-a
Statutory History of R. S. 4887	9-a
Statutory History of R. S. 4923	12-a



R. S. 4886**Section 31. Inventions Patentable.**

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

(R. S. 4886; May 23, 1930, 46 Stat. L. 376.)

R. S. 4887**Section 32. Inventions Previously Patented
Abroad.**

No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section forty-eight hundred and eighty six of the Revised Statutes, and six months in cases of designs, prior to the filing of

the application in this country, in which case no patent shall be granted in this country.

An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privilege to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and within six months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing. (R. S. 4887; March 3, 1897, 29 Stat. L. 693; March 3, 1903, 32 Stat. L. 1225; June 19, 1936, 49 Stat. L. 1529.)

R. S. 4892

Section 35. Oath of Applicant.

The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manu-

facture, composition, or improvement, or of the variety of plant, for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States. (R. S. 4892; March 3, 1903; 32 Stat. L. 1226; May 23, 1930, 46 Stat. L. 376.)

R. S. 4920

Section 69. Pleading and Proof in Actions for Infringement.

In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact in-

vented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than two years prior to his application for a patent therefor; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect. (R. S. 4920; March 3, 1897, 29 Stat. L. 692.)

R. S. 4923

Section 72. Patent Not Void for Previous Use of Thing in Foreign Country.

Whenever it appears that a patentee, at the time of making his application for the patent, be-

lieved himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication. (R. S. 4923.)

RULES OF PRACTICE IN THE UNITED STATES PATENT OFFICE

Rule 126.

The examiner of interferences or the board of appeals may, either before or in their decision on the question of priority, direct the attention of the Commissioner to any matter not relating to priority which may have come to their notice, and which, in their opinion, establishes the fact that no interference exists, or that there has been irregularity in declaring the same (rule 122), or which amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The Commissioner may suspend the interference and remand the case to the primary examiner for his consideration of the matters to which attention has been directed. From the decision of the Examiner appeal may be taken as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment consider any matter affecting the rights of either party to a patent which may have been called to his attention, unless the same shall have been previously disposed of by the Commissioner.

STATUTORY HISTORY OF R. S. 4886

The Patent Act of 1790 (1 Stat. 109) §1 thereof provided for the grant of Letters Patent—

“... That upon the petition of any person or persons . . . setting forth, that he, she, or they, hath or have invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used, . . .”

The Patent Act of 1793 (1 Stat. 318) §1 repealed the act heretofore made (Patent Act of 1790) and provided—

“That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement on any art, machine, manufacture or composition of matter, not known or used before the application, and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor . . .”

The Patent Act of 1800 (2 Stat. 37) §1 extended the privilege of obtaining patents for useful discoveries and inventions, to certain persons therein mentioned, providing—

“That all and singular the rights and privileges given, intended or provided to citizens of the United States, respecting patents for new inventions, discoveries, and improvements, by the act, entitled ‘An act to promote the progress of useful arts, and to repeal the act heretofore made for

that purpose', shall be, and hereby are extended and given to all aliens who at the time of petitioning in the manner prescribed by the said act, shall have resided for two years within the United States, which privileges shall be obtained, used, and enjoyed, by such persons, in as full and ample manner, and under the same conditions, limitations and restrictions, as by the said act is provided and directed in the case of citizens of the United States. **Provided always,** That every person petitioning for a patent for any invention, art or discovery, pursuant to this act, shall make oath or affirmation before some person duly authorized to administer oaths before such patent shall be granted, that such invention, art or discovery hath not, to the best of his or her knowledge or belief, been known or used either in this or any foreign country; and that every patent which shall be obtained pursuant to this act, for any invention, art or discovery, which it shall afterwards appear had been known or used previous to such application for a patent, shall be utterly void."

The Patent Act of 1836 (5 Stat. 117) §6 repealed the foregoing, providing—

"That any person or persons having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture or composition of matter, not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer, and shall desire to obtain an exclusive

property therein, may make application in writing to the Commissioner of Patents, expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor . . .”

The Consolidated Patent Act of 1870 (16 Stat. 198) in turn repealed the Act of 1836, §24 of the Act of 1870 providing—

“That any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented, or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the duty required by law, and other due proceedings had, obtain a patent therefor.”

With the enactment in 1874 of the Revised Statutes, §24 of the Consolidated Patent Act of 1870 became, without change, R. S. 4886.

The Act of 1897 (29 Stat. 692) amended R. S. 4886 to read as follows:

“Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not

in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

The amendment to R. S. 4886, by the Act of May 23, 1930 (46 Stat. 376) relating to plant patents, is not here pertinent.

STATUTORY HISTORY OF R. S. 4887

R. S. 4487 had its origin in §8 of the Patent Act of 1836, which provided in part as follows:

"But nothing in this act contained shall be construed to deprive an original and true inventor, of a right to a patent for his invention by reason of his having previously taken out Letters Patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings."

The Patent Act of 1839 (5 Stat. 353) §6 amended §8 of the Patent Act of 1836 to read as follows:

"That no person shall be debarred from receiving a patent for any invention or discovery, as provided in the act approved on the fourth day of July, one thousand eight hundred and thirty-six, to which this is additional, by reason of the same having been patented in a foreign country more than six months prior to his application: **Provided**, That the same shall not have been introduced into public and common use in the United States, prior to the application for such patent: **And Provided, also**, That in all cases every such

patent shall be limited to the term of fourteen years from the date of publication of such foreign letters patent.

The Consolidated Patent Act of 1870 (16 Stat. 198) §25 again changed the provision to read:

"That no person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country; **provided** the same shall not have been introduced into public use in the United States for more than two years prior to the application, and that the patent shall expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term; but in no case shall it be in force more than seventeen years."

With enactment of the Revised Statutes in 1874 this Section, with certain modifications, became R. S. 4887, as follows:

"No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent; or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years."

The Patent Act of 1897 again amended R. S. 4887 to read as follows:

"No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than seven months prior to the filing of the application in this country, in which case no patent shall be granted in this country."

The Patent Act of 1903 further amended R. S. 4887 to read as follows:

"No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and four months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

"An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar priv-

ileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing."

R. S. 4887 is at present as above amended with the exception of the amendment by the Act of 1936 (49 Stat. 1529) providing for the extension of the convention period in cases of designs from four to six months.

STATUTORY HISTORY OF R. S. 4923

R. S. 4923 first appears as a portion of §15 of the Patent Act of 1836, providing:

"... That whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent, believed himself to be the first inventor or discoverer of the thing patented, the same shall not be held to be void on

account of the invention or discovery or any part thereof having been before known or used in any foreign country, it not appearing that the same or any substantial part thereof had before been patented or described in any printed publication

The foregoing portion of §15 of the Patent Act of 1836 was somewhat changed and became §62 of the Consolidated Patent Act of 1870, reading:

"That whenever it shall appear that the patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication."

In 1874 with the enactment of the Revised Statutes, §62 of the Consolidated Patent Act of 1870 became R. S. 4923 with the opening phrase beginning with "That whenever it shall appear that the patentee" changed to "Whenever it appears that a patentee". R. S. 4923 has not since been changed.